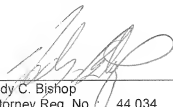
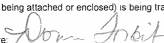



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|---|---------------------------------|------------------------|-------------------------------------|--|
| TRANSMITTAL OF APPEAL BRIEF | | | Docket No. 66729/P038US/10614714 | |
| In re Application of: Roy Schoenberg | | | | |
| Application No. 10/727,184 | Filing Date December 3, 2003 | Examiner Kuen S. Lu | Group Art Unit 2169 | |
| Invention: RANGE DEFINITION METHOD AND SYSTEM | | | | |
| <u>TO THE COMMISSIONER OF PATENTS:</u> | | | | |
| Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed <u>Herewith</u> . | | | | |
| The fee for filing this Appeal Brief is <u>\$ 540.00</u> . | | | | |
| <input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity | | | | |
| <input type="checkbox"/> A petition for extension of time is also enclosed. | | | | |
| The fee for the extension of time is _____. | | | | |
| <input type="checkbox"/> A check in the amount of _____ is enclosed. | | | | |
| <input type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>50-3948</u> . | | | | |
| <input checked="" type="checkbox"/> Payment in the amount of \$540.00 is being paid on line by credit card. | | | | |
| <input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-3948</u> . This sheet is submitted in duplicate. | | | | |
|  _____ Jody C. Bjshop Attorney Reg. No. 44,034 FULBRIGHT & JAWORSKI L.L.P. 2200 Ross Avenue, Suite 2800 Dallas, Texas 75201-2784 (214) 855-8007 | | | Dated: <u>June 19, 2009</u> | |
| <div style="text-align: center;"> Appeal Brief Transmittal I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4). </div> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 10px;"> Dated: June 19, 2009 <div style="text-align: center;"> Signature:  _____ (Donna Forbit) </div> </div> | | | | |

Appeal Brief

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: June 19, 2009 Signature: 

(Donna Forbit)

Docket No.: 66729/P038US/10614714
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Roy Schoenberg

Application No.: 10/727,184

Confirmation No.: 4980

Filed: December 3, 2003

Art Unit: 2169

For: RANGE DEFINITION METHOD AND
SYSTEM

Examiner: K. S. Lu

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under 37 C.F.R. § 41.37(a), this brief is filed within two months of the Notice of Appeal filed concurrently herewith, and is in furtherance of said Notice of Appeal.

The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

| | |
|-------|---|
| I. | Real Party In Interest |
| II. | Related Appeals and Interferences |
| III. | Status of Claims |
| IV. | Status of Amendments |
| V. | Summary of Claimed Subject Matter |
| VI. | Grounds of Rejection to be Reviewed on Appeal |
| VII. | Argument |
| VIII. | Claims Appendix |
| IX. | Evidence Appendix |
| X. | Related Proceedings Appendix |

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

The TriZetto Group, Inc.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

Appellant respectfully notes that there is a pending appeal before the Board for U.S. patent application serial number 10/315,514 titled “METHOD OF AND SYSTEM FOR INTEGRATING HEALTH INFORMATION INTO A PATIENT’S RECORD” (hereafter “the ‘514 application”), which is commonly assigned with the present application. One of the references at issue in the appeal for the ‘514 application is U.S. Patent Publication No. 2002/0029157 to Marchosky, which is similar to the *Marchosky* reference (U.S. Patent Application Publication No. 2003/0050803) applied in the rejection of the present application. The claimed subject matter at issue in the appeal of the ‘514 application appears significantly different from the claimed subject matter at issue in the present appeal, but Appellant notes the pending appeal of the ‘514 application for the Board’s consideration merely because of the similarity of the *Marchosky* references at issue in each appeal. In the appeal of the ‘514 application, an Examiner’s Answer was filed March 18, 2009, and a Reply Brief was filed April 24, 2009. No decision has been rendered as of yet in the appeal of the ‘514 application.

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 27 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 11-20, 31-40, and 43-52
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-10, 21-30, 41-42, and 53-57
4. Claims allowed: None
5. Claims rejected: 1-10, 21-30, 41-42, and 53-57

C. Claims On Appeal

The claims on appeal are claims 1-10, 21-30, 41-42, and 53-57.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed March 30, 2009, which finally rejected claims 1-10, 21-30, 41-42, and 53-57. In response, Applicant filed a response that did not present any claim amendments, but which instead presented arguments traversing the grounds of rejection. An Advisory Action was then mailed June 8, 2009, which maintained the rejections. In response to the Advisory Action, Applicant filed the present appeal.

Accordingly, because no claim amendments were presented in the response to the Final Office Action, the claims on appeal are those as rejected in the Final Office Action. A complete listing of the claims is provided in the Claims Appendix hereto.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the separately argued claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. It should be noted that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

According to one claimed embodiment, such as that of independent claim 1, a range-conversion method comprises receiving medical data records (*see e.g.*, receiving operation of block 138 of FIGURE 4 and *see* medical data records 62, 64, and 66 of FIGURE 2), wherein each of the medical data records includes at least a portion of a corresponding patient's medical history that includes one or more data fields and a field value associated with each data field (*see e.g.*, exemplary fields of medical record 62 of FIGURE 5). The method further comprises identifying one or more of said data fields as a range-based data field (*see e.g.*, operational block 148 of FIGURE 4); and defining (*see e.g.*, operational block 150 of FIGURE 4), by an authorized user who has authorized access to the medical data records (*see e.g.*, medical service providers 17-19 of FIGURE 1, and *see* paragraphs 0027-0033 at page 8, line 3 – page 10, line 2 and paragraphs 0048-0049 at page 13, lines 3-21 of the specification), a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields (*see e.g.*, paragraphs 0035-0045 at page 10, line 8 – page 12, line 19 of the specification).

In one embodiment, such as that recited by dependent claim 6, a specific data record includes a range-based data field, and the range-conversion method further comprises incorporating, as the value descriptor of the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record (*see e.g.*, paragraphs 0035-0047 at page 10, line 8 – page 13, line 2 of the specification).

In one embodiment, such as that recited by dependent claim 53, each of the defined text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor (*see e.g.*, paragraphs 0035-0045 at page 10, line 8 – page 12, line 19 of the specification).

According to another claimed embodiment, such as that of independent claim 21, a computer program product residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by the processor, cause that processor to: receive medical data records (*see e.g.*, medical data records 62, 64, and 66 of FIGURE 2), wherein each of the medical data records includes at least a portion of a corresponding patient's medical history that includes one or more data fields and a field value associated with each data field (*see e.g.*, exemplary fields of medical record 62 of FIGURE 5); receive user selection of one or more of said data fields as a range-based data field (*see e.g.*, paragraphs 0044-0045 at page 12, lines 1-19 of the specification); and receive user definition of a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for the selected one or more of the range-based data fields (*see e.g.*, paragraphs 0044-0045 at page 12, lines 1-19 of the specification).

In one embodiment, such as that of dependent claim 26, a specific data record includes a range-based data field, and the computer program product further comprises instructions for incorporating, as the value descriptor of the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record (*see e.g.*, paragraphs 0035-0047 at page 10, line 8 – page 13, line 2 of the specification).

In one embodiment, such as that of dependent claim 56, each of the defined text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor (*see e.g.*, paragraphs 0035-0045 at page 10, line 8 – page 12, line 19 of the specification).

According to another claimed embodiment, such as that of independent claim 41, a searching system comprises a server system including a computer processor and associated memory (*see e.g.*, computer 26 of FIGURE 1, and paragraphs 0020-0021 at page 6, line 17 – page 7, line 2 of the specification), the server system having a database that includes a plurality of medical data records (*see e.g.*, medical record repository 52 of FIGURE 2, which is illustrated as part of record organization system 10 implemented on server computer 26 of FIGURE 1; and *see* paragraphs 0023-0024 at page 7, lines 7-22 of the specification), wherein each of the medical data records includes at least a portion of a corresponding patient's medical history (*see e.g.*, exemplary fields of medical record 62 of FIGURE 5). The server system is configured to: receive medical data records (*see e.g.*, receiving operation of block 138 of FIGURE 4 and *see* medical data records 62, 64, and 66 of FIGURE 2), wherein each data record includes one or more data fields and a field value associated with each data field, and wherein said field value includes a patient-specific value for the corresponding patient (*see e.g.*, exemplary fields of medical record 62 of FIGURE 5); identify one or more of said data fields as a range-based data field that can accept any numeric value within a range of valid numeric values (*see e.g.*, operational block 148 of FIGURE 4); and define a plurality of text-based range descriptors (*see e.g.*, operational block 150 of FIGURE 4), wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields, wherein each of the text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor (*see e.g.*, paragraphs 0035-0045 at page 10, line 8 – page 12, line 19 of the specification).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claim 41 is objected to; and

B. Claims 1-10, 20-30, 41-42, and 53-57 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,104,798 to Lickiss et al. (hereinafter "*Lickiss*") in view of U.S. Patent Application Publication No. 2003/0050803 to Marchosky (hereinafter "*Marchosky*").

VII. ARGUMENT

Appellant respectfully traverses the outstanding rejections of the pending claims, and requests that the Board reverse the outstanding rejections in light of the remarks contained herein. The claims do not stand or fall together. Instead, Appellant presents separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

A. Objection to Claim 41

Claim 41 recites, in part, "wherein the server system is configured to:" perform certain operations. The Final Office Action objects to this language contending that it does "not positively recite the limitation so preceded is required to be performed by the invention covered by the claim", *see* page 2 of the Final Office Action.

Rejection Not Timely Raised By the Examiner

First, Appellant notes that the language at issue (i.e., "wherein the server system is configured to:" perform certain operations) was present in claim 41 as originally filed. Further, the Examiner objected to claim 41 for the first time in the Final Office Action. Clearly, this issue was not raised by Applicant's previous amendment because the language at issue was present in claim 41 as originally filed. Thus, the Finality of the Final Office Action in raising this objection to claim 41 for the first time was improper because it did not afford Applicant a full and fair opportunity to respond to this objection. Because the objection was raised for the first time in

the Final Office Action, Applicant was not even afforded a proper opportunity to amend claim 41, if deemed that an amendment would be appropriate for overcoming the rejection. However, as discussed further below, Appellant respectfully submits that the objection is improper and should be overturned altogether without any amendment being necessitated.

Objection of Claim 41 is Improper

It is unclear on what basis the language of claim 41 is objected to. Appellant notes that the Examiner does not contend that the language is unclear (under 35 U.S.C. 112, second paragraph). Instead, the Final Office Action objects to this language as not positively reciting the limitations required to be performed by the claim. Appellant respectfully disagrees.

Claim 41 positively recites that the server system “is” configured to perform the operations of “receive medical data records”, “identify one or more of said data fields as a range-based data field”, and “define a plurality of text-based range descriptors”. Claim 41 does not recite, for example, that the server system “may be” or “could be” so configured, but instead positively recites that it “is” so configured to perform the recited operations.

In response to the above arguments, the Advisory Action does not offer any further reasoning in support of the rejection other than asserting that the objection “is made based on the guidelines provided by the Office.” *See* item 2 on the continuation sheet of the Advisory Action. No specific “guideline” has been identified by the Examiner, nor has any explanation been offered by the Examiner to overcome the above arguments that the language of claim 41 positively recites that the server system “is” configured to perform the recited operations and is thus proper.

In view of the above, Appellant respectfully submits that the objection to claim 41 is improper and should be overturned because claim 41 clearly recites that the server system is configured to perform the recited operations, thus making clear that such a configuration of the server system for performing the recited operations is required by the claim.

B. Rejections Under 35 U.S.C. §103 over *Lickiss* in view of *Marchosky*

Claims 1-10, 20-30, 41-42, and 53-57 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lickiss* in view of *Marchosky*. Appellant respectfully traverses these rejections for the reasons discussed hereafter.

The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in Graham v. John Deere and Co., 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. As discussed further hereafter, Appellant respectfully asserts that the claims include non-obvious differences over the cited art.

As discussed further below, the rejections should be overturned because when considering the scope and content of the applied *Lickiss* and *Marchosky* references there are significant differences between the applied combination and claims 1-10, 20-30, 41-42, and 53-57, as the applied combination fails to disclose all limitations of these claims. Thus, considering the lack of disclosure in the applied combination of all limitations of claims 1-10, 20-30, 41-42, and 53-57, one of ordinary skill in the art would not find these claims obvious under 35 U.S.C. §103, and therefore the rejections should be withdrawn.

Discussion of Applied *Lickiss* and *Marchosky* References

Before addressing the specific claim rejections raised in the Office Action, Appellant briefly addresses the disclosure of the applied *Lickiss* and *Marchosky* references for the convenience of the Board.

Lickiss

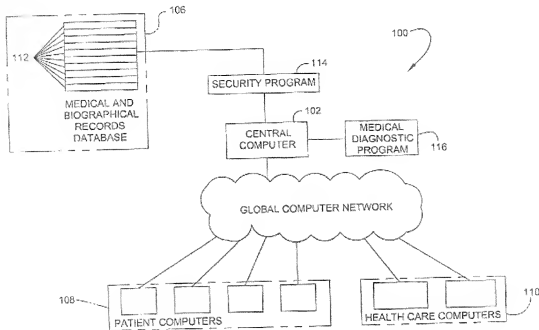
Lickiss is directed generally to an “automated order processing system for a telecommunications services carrier is capable of activating customer orders and provisioning telecommunications services for customers.” Abstract of *Lickiss*. *Lickiss* does not provide any disclosure whatsoever concerning medical data records, but is instead concerned with activating customer orders for telecommunications services. As the Final Office Action concedes (*see* page 3 thereof), *Lickiss* provides no teaching whatsoever regarding medical data records.

Marchosky

Unlike *Lickiss*, *Marchosky* is not directed to customer orders or provisioning of telecommunications services, but is instead directed to a much different problem concerning diagnosing medical patients. *Marchosky* is directed generally to a medical records database and medical diagnostic program, *see* Abstract. Individual patient medical and biographical records (that are stored to the medical records database) are owned by individual patients who can enter information in their record as well as grant or deny authorization to others, such as health care professionals. *Id.* The diagnostic program provides a series of diagnostic questions to an individual who must respond either “yes” or “no” to each question. *See* paragraph 0021 of *Marchosky*. Each potential response is weighted relative to its importance to a particular diagnosis, and the weights for the responses are summed to identify potential diagnoses. *See* paragraph 0024 of *Marchosky*. The list of potential diagnoses determined for a patient may be saved to the patient’s individual medical record.

Figure 1 of *Marchosky* is reproduced below.

FIG. 1



As shown in Figure 1, *Marchosky* explains compiling patient-specific medical/biographical records 112. Further, a medical diagnostic program 116 that is external to the data records 112 is included for the purpose of aiding a user in gathering information to be used for diagnosing the patient. Paragraphs 0153-0179 of *Marchosky* and the Tables I-VI (portions of which the Final Office Action relies upon) are directed to describing the operation of the medical diagnostic program 116 and the codes that it employs for its operation in evaluating input responses for diagnosing a patient.

While *Marchosky* mentions medical records (unlike *Lickiss*), *Marchosky* fails to provide any disclosure whatsoever of range-based data fields in the medical records or of an authorized user defining text-based range descriptors that are associated with a range of field values for the range-based data fields contained in the medical records, as examples.

Independent Claim 1 and Dependent Claims 2-5, 10, and 54-55

i. Applied Combination Fails to Teach or Suggest All Claim Limitations

Independent claim 1 recites:

A range-conversion method comprising:
receiving medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient's medical history that includes one or more data fields and a field value associated with each data field;
identifying one or more of said data fields as a range-based data field; and
defining, by an authorized user who has authorized access to the medical data records, a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields. (Emphasis added).

The applied combination of *Lickiss* and *Marchosky* fails to teach or suggest at least the above-emphasized limitations of claim 1. Claim 1 is directed to medical data records that include at least a portion of a corresponding patient's medical history. As is well known in the art, such medical records are special types of data records due to the sensitive nature of the information they contain and the restrictive access to such information to only certain authorized users, such as a patient's physician. As discussed below, neither *Lickiss* nor the portion of *Marchosky* being relied upon by the Examiner in the Final Office Action concern medical data records (while *Marchosky* mentions medical records, e.g., database 112 of its FIGURE 1, the Examiner cites to portions of *Marchosky* that discuss the separate medical diagnostic program, e.g., program 116 of FIGURE 1, rather than the medical records).

In addition, claim 1 recites that the medical history includes one or more data fields that are identified as a range-based data field, and an authorized user (e.g., a patient's physician) defines a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of values for one of the range-based data fields. For instance, as discussed in paragraphs 0044-0045 of the present application, one such range-based data field included a medical record may be a cholesterol field for a patient, and a text-based range descriptor of "1" may be defined to represent a total cholesterol reading of <150, a text-based

range descriptor of “2” may be defined to represent a total cholesterol reading of 150-199, a text-based range descriptor of “3” may be defined to represent a total cholesterol reading of 200-239, a text-based range descriptor of “4” may be defined to represent a total cholesterol reading of 240-274, and a text-based range descriptor of “5” may be defined to represent a total cholesterol reading of >275.

As discussed further hereafter, *Lickiss* and *Marchosky* do not propose any such text-based range descriptors for a range-based data field of a medical record. *Lickiss* does not concern medical data records at all, and while *Marchosky* proposes that its medical diagnostic program may employ a range of codes for its operation in evaluating input responses to questions for attempting to diagnose a patient (see paragraphs 0153-0179 of *Marchosky*), it simply fails to address any such descriptor for range-based medical history data contained in the medical data records. Thus, the applied combination of references is completely lacking any teaching or suggestion of a text-based range descriptor for a range-based data field of a medical record.

Further, *Marchosky* fails to teach or suggest that an authorized user who has authorized access to the medical data records defines the text-based range descriptors on which the Final Office Action relies as meeting this limitation. The Final Office Action contends that the sub-sectors in Table IV which are discussed in paragraph 0168 of *Marchosky* constitute the recited text-based range descriptors. For instance, Table IV of *Marchosky* illustrates “acute pain” having a range of digital codes (from 0-10). However, these digital codes are not taught by *Marchosky* as being range-based data fields in the medical records, but are rather digital codes employed by its medical diagnostic program for controlling the operation of that program in evaluating input responses to questions for attempting to diagnose a patient (see paragraphs 0153-0179 of *Marchosky*). Further, *Marchosky* does not teach or suggest that an authorized user defines the text-based range descriptor (e.g., “acute pain”), but instead that “descriptor” appears to be hard-coded into or pre-defined by the medical diagnostic program of *Marchosky* (rather than allowing a physician or other authorized user to define such text-based ranged descriptor, as recited by claim 1).

In conclusion, the combination of *Lickiss* and *Marchosky* fails to teach or suggest an authorized user defining text-based range descriptors that are associated with a range of field

values for the range-based data fields contained in the medical records. The Final Office Action contends that *Marchosky* discloses this limitation. However, the portions of *Marchosky* that are relied upon by the Final Office Action concern the internal coding/operation of its medical diagnostic program which is employed for evaluating input answers from a user in attempt to diagnose a patient. The relied-upon disclosure of *Marchosky* does not teach or suggest range-based data fields contained in medical records. Further, the relied-upon disclosure of *Marchosky* does not teach or suggest an authorized user defining the text-based range descriptors.

Accordingly, the combination of *Lickiss* and *Marchosky* does not teach or suggest all limitations of claim 1. Therefore, Appellant respectfully requests that the rejection of claim 1 be overturned.

ii. No Apparent Reason to Combine Applied References in the Manner Suggested

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner cannot satisfy this burden through “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1396 (2007) (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006)). Moreover, the Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and “[such] analysis should be made explicit,” *KSR*, 127 S.Ct. at 1741.

As discussed above, the Final Office Action applies a combination of two very different references in attempt to arrive at the claimed invention through piecemeal application of the references. For instance, *Lickiss* is directed generally to an “automated order processing system for a telecommunications services carrier is capable of activating customer orders and provisioning telecommunications services for customers” (abstract of *Lickiss*), while *Marchosky* is directed generally to a medical records database and medical diagnostic program (abstract of

Marchosky). One reference concerns providing telecommunication services to customers while the other reference concerns the much different issue of diagnosing medical patients.

Further, sufficient rationale has not been provided to establish why one of ordinary skill in the art would be motivated to combine such disparate teachings in the manner applied by the Examiner absent the use of impermissible hindsight in which the present application is used as a blue print to piece the elements together in the manner claimed. The reasoning stated in the Final Office Action for combining *Lickiss* and *Marchosky* is “because both references are directed to provide services and carriers for a great large number of records where records indexes and access authorization would have enhanced Lickiss’ system for providing more accurate reports and more timely status on-line data to its clients.” Pages 3-4 of the Final Office Action. However, it is completely unclear how, if at all, the medical record repository of *Marchosky*, and in particular the medical diagnostic program of *Marchosky* (which is relied upon by the Examiner’s rejection, as discussed above), could be adapted for use in the telecommunication provisioning system of *Lickiss* to achieve the alleged improved accuracy in reports and/or more timely on-line data.

Appellant maintains that one of ordinary skill in the art would not find objective reasoning for combining the medical record repository of *Marchosky* with *Lickiss* in order to improve the accuracy and/or timeliness of reporting of the telecommunication data in *Lickiss*, and the Final Office Action fails to offer any explanation regarding how such improved accuracy and/or timeliness would be achieved through application of *Marchosky*’s medical record repository or the medical diagnosis program of *Marchosky* (which is what the portion of *Marchosky* being relied upon by the Examiner describes) in *Lickiss*. Indeed, adding the capability of the medical diagnostic program of *Marchosky* (which is the portion of *Marchosky* that is relied upon by the rejection) with the telecommunication ordering system of *Lickiss* in the manner suggested by the Examiner does not provide any improved accuracy in reporting or more timely status as asserted by the Examiner, but might instead result in a system that can both manage customer orders for telecommunication services and provide medical diagnosis for those customers!

Clearly, the two very different references are being combined in piecemeal fashion using impermissible hindsight in which the present application is effectively being used as a blue print by the Examiner to piece the disparate reference teachings together in attempt to arrive at the claimed subject matter. Thus, the rejections based on the applied combination of *Lickiss* and *Marchosky* should be withdrawn for this further reason.

Further, dependent claims 2-5, 10, and 54-55 depend either directly or indirectly from independent claim 1 and thus inherit all limitations of claim 1. Therefore, these dependent claims 2-5, 10, and 54-55 are likewise believed allowable over the combination of *Lickiss* and *Marshosky* based at least on their dependency from claim 1 for the reasons presented above.

Dependent Claims 6-9

Dependent claims 6-9 depend either directly or indirectly from independent claim 1 and thus inherit all limitations of claim 1. Therefore, these dependent claims 6-9 are likewise believed allowable over the combination of *Lickiss* and *Marshosky* based at least on their dependency from claim 1 for the reasons presented above.

In addition, dependent claim 6 recites “wherein a specific data record includes a range-based data field, the range-conversion method further comprising: incorporating, as the value descriptor of the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record” (emphasis added). The applied combination of *Lickiss* and *Marchosky* fails to teach or suggest this further limitation of claim 6, as discussed below.

The Final Office Action first relies upon *Marchosky* as disclosing the recited text-based range descriptor. As discussed above with claim 1, the portions of *Marchosky* that are relied upon concern the internal coding/operation of its medical diagnostic program which is employed for evaluating input answers from a user in attempt to diagnose a patient. The cited portions of *Marchosky* that are asserted by the Examiner as disclosing the recited “text-based range descriptor” are not associated with a range of field values for the range-based data fields

contained in the medical records. For instance, Table IV of *Marchosky* illustrates “acute pain” having a range of digital codes (from 0-10). However, these digital codes are not taught by *Marchosky* as being range-based data fields in the medical records, but are rather digital codes employed by its medical diagnostic program for controlling the operation of that program in evaluating input responses to questions for attempting to diagnose a patient (*see* paragraphs 0153-0179 of *Marchosky*).

In its treatment of dependent claim 6, the Final Office Action relies upon the “Working Telephone Number” file shown in figure 9 of *Lickiss* as disclosing the recited text-string associated with the specific data record, *see* pages 6-7 of the Final Office Action. The Final Office Action appears to propose that the digital codes of *Marchosky* (which are employed for controlling its medical diagnostic program) would somehow be employed as a text-based range descriptor for use in the working telephone number file of *Lickiss*. This further illuminates that the applied combination of the disparate teachings of *Lickiss* and *Marchosky* is improper and nonsensical.

Therefore, the rejection of claim 6, as well as the rejection of claims 7-9 which depend either directly or indirectly from claim 6, should be overturned for this further reason.

Dependent Claim 53

Dependent claim 53 depends from independent claim 1 and thus inherits all limitations of claim 1. Therefore, dependent claim 53 is believed allowable over the combination of *Lickiss* and *Marshosky* based at least on its dependency from claim 1 for the reasons presented above.

As discussed above, claim 1 recites “receiving medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient’s medical history that includes one or more data fields and a field value associated with each data field; identifying one or more of said data fields [of the medical data record] as a range-based data field; and defining ... a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields [of the medical data

record]” (emphasis added). In addition, claim 53 recites “wherein each of the defined text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor.” The recited “the range of field values associated with the text-based range descriptor” of claim 53 refers to the range of field values of the recited medical data record of claim 1.

As discussed above, the Final Office Action relies upon the disclosure in *Marchosky* of a text description (e.g., “acute pain”) that corresponds to a range of digital codes that are used by a diagnostic program as the recited text-based range descriptors. For instance, Table IV of *Marchosky* illustrates “acute pain” having a range of digital codes (from 0-10). However, these digital codes are not taught by *Marchosky* as being range-based data fields in the medical records, but are rather digital codes employed by its medical diagnostic program for controlling the operation of that program in evaluating input responses to questions for attempting to diagnose a patient (*see* paragraphs 0153-0179 of *Marchosky*). Thus, *Marchosky* fails to teach or suggest this further limitation of claim 53, nor does *Lickiss* teach or suggest this limitation (as *Lickiss* does not teach or suggest any medical data record).

Therefore, the rejection of claim 53 should be overturned for this further reason.

Independent Claim 21 and Dependent Claims 22-25, 30, and 57

Independent claim 21 recites:

A computer program product residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by the processor, cause that processor to:

receive medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient's medical history that includes one or more data fields and a field value associated with each data field;

receive user selection of one or more of said data fields as a range-based data field; and

receive user definition of a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for the selected one or more of the range-based data fields.

For reasons similar to those discussed above with claim 1, independent claim 21 is believed to be patentable over the applied combination of *Lickiss* and *Marchosky*. For instance, neither *Lickiss* nor *Marchosky* teaches or suggests receiving a user definition of a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for selected one or more range-based data fields of a medical data record, as recited by claim 21. As discussed above with claim 1, *Marchosky* discusses text-based range descriptors for internal codes employed by its medical diagnostic program (rather than text-based range descriptors for fields of a medical data record), and *Marchosky* does not teach or suggest receiving user definition of such text-based range descriptors (but instead its text-based range descriptors are hard-coded or pre-defined by the medical diagnostic program).

In addition, as argued above with claim 1, there is no apparent reason to combine the disparate teachings of *Lickiss* and *Marchosky* in the manner suggested by the Examiner. Therefore, the rejection of claim 21 is improper for this further reason.

In view of the above, Appellant respectfully requests that this rejection of independent claim 21 also be overturned.

Further, dependent claims 22-25, 30, and 57 depend either directly or indirectly from independent claim 21 and thus inherit all limitations of claim 21. Therefore, these dependent

claims 22-25, 30, and 57 are likewise believed allowable over the combination of *Lickiss* and *Marshosky* based at least on their dependency from claim 21 for the reasons presented above.

Dependent Claims 26-29

Dependent claims 26-29 depend either directly or indirectly from independent claim 21 and thus inherit all limitations of claim 21. Therefore, these dependent claims 26-29 are likewise believed allowable over the combination of *Lickiss* and *Marshosky* based at least on their dependency from claim 21 for the reasons presented above.

In addition, dependent claim 26 recites “wherein a specific data record includes a range-based data field, the computer program product ... further comprising instructions for: incorporating, as the value descriptor of the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record” (emphasis added). The applied combination of *Lickiss* and *Marchosky* fails to teach or suggest this further limitation of claim 26, as discussed below.

The Final Office Action first relies upon *Marchosky* as disclosing the recited text-based range descriptor. As discussed above with claim 1, the portions of *Marchosky* that are relied upon concern the internal coding/operation of its medical diagnostic program which is employed for evaluating input answers from a user in attempt to diagnose a patient. The cited portions of *Marchosky* that are asserted by the Examiner as disclosing the recited “text-based range descriptor” are not associated with a range of field values for the range-based data fields contained in the medical records. For instance, Table IV of *Marchosky* illustrates “acute pain” having a range of digital codes (from 0-10). However, these digital codes are not taught by *Marchosky* as being range-based data fields in the medical records, but are rather digital codes employed by its medical diagnostic program for controlling the operation of that program in evaluating input responses to questions for attempting to diagnose a patient (*see* paragraphs 0153-0179 of *Marchosky*).

In its treatment of dependent claim 26, the Final Office Action relies upon the “Working Telephone Number” file shown in figure 9 of *Lickiss* as disclosing the recited text-string associated with the specific data record, *see* pages 6-7 of the Final Office Action. The Final Office Action appears to propose that the digital codes of *Marchosky* (which are employed for controlling its medical diagnostic program) would somehow be employed as a text-based range descriptor for use in the working telephone number file of *Lickiss*. This further illuminates that the applied combination of the disparate teachings of *Lickiss* and *Marchosky* is improper and nonsensical.

Therefore, the rejection of claim 26, as well as the rejection of claims 27-29 which depend either directly or indirectly from claim 26, should be overturned for this further reason.

Dependent Claim 56

Dependent claim 56 depends from independent claim 21 and thus inherits all limitations of claim 21. Therefore, dependent claim 56 is believed allowable over the combination of *Lickiss* and *Marshosky* based at least on its dependency from claim 21 for the reasons presented above.

As discussed above, claim 21 recites “receive medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient’s medical history that includes one or more data fields and a field value associated with each data field; receive user selection of one or more of said data fields [of the medical data record] as a range-based data field; and receive user definition of a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for the selected one or more of the range-based data fields [of the medical data record]” (emphasis added). In addition, claim 56 recites “wherein each of the defined text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor” (emphasis added). The recited “the range of field values associated with the text-based range descriptor” of claim 56 refers to the range of field values of the recited medical data record of claim 21.

As discussed above, the Final Office Action relies upon the disclosure in *Marchosky* of a text description (e.g., “acute pain”) that corresponds to a range of digital codes that are used by a diagnostic program as the recited text-based range descriptors. For instance, Table IV of *Marchosky* illustrates “acute pain” having a range of digital codes (from 0-10). However, these digital codes are not taught by *Marchosky* as being range-based data fields in the medical records, but are rather digital codes employed by its medical diagnostic program for controlling the operation of that program in evaluating input responses to questions for attempting to diagnose a patient (*see* paragraphs 0153-0179 of *Marchosky*). Thus, *Marchosky* fails to teach or suggest this further limitation of claim 56, nor does *Lickiss* teach or suggest this limitation (as *Lickiss* does not teach or suggest any medical data record).

Therefore, the rejection of claim 56 should be overturned for this further reason.

Independent Claim 41 and Dependent Claim 42

Independent claim 41 recites:

A searching system comprising:
a server system including a computer processor and associated memory, the server system having a database that includes a plurality of medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient's medical history;
wherein the server system is configured to:
receive medical data records, wherein each data record includes one or more data fields and a field value associated with each data field, and wherein said field value includes a patient-specific value for the corresponding patient;
identify one or more of said data fields as a range-based data field that can accept any numeric value within a range of valid numeric values; and
define a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields, wherein each of the text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor.

For reasons similar to those discussed above with claim 1, independent claim 41 is believed to be patentable over the applied combination of *Lickiss* and *Marchosky*. For instance, the applied combination of *Lickiss* and *Marchosky* fails to teach or suggest a server system that is configured to “define a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields [included in the medical records], wherein each of the text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor”. As discussed above with claim 1, *Lickiss* fails to provide any medical records whatsoever. *Marchosky* mentions medical records, but does not teach or suggest use of text-based range descriptors as being associated with a range of field values included in the medical records. The portion of *Marchosky* relied upon by the Final Office Action concerns the internal coding/operation of its medical diagnostic program which is employed for evaluating input answers from a user in attempt to diagnose a patient,

rather than teaching or suggesting any text-based range descriptors that are associated with range-based data fields included in the medical records.

In addition, as argued above with claim 1, there is no apparent reason to combine the disparate teachings of *Lickiss* and *Marchosky* in the manner suggested by the Examiner. Therefore, the rejection of claim 41 is improper for this further reason.

In view of the above, Appellant respectfully requests that this rejection of independent claim 41 also be overturned. Further, dependent claim 42 depends from independent claim 41 and thus inherits all limitations of claim 41. Therefore, dependent claim 42 is likewise believed allowable over the combination of *Lickiss* and *Marshosky* based at least on its dependency from claim 41 for the reasons presented above.

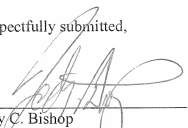
Conclusion

In view of the above, Appellant requests that the board overturn the outstanding rejections of claims 1-10, 21-30, 41-42, and 53-57. Attached hereto are a Claims Appendix, Evidence Appendix, and Related Proceedings Appendix. As noted in the attached Evidence Appendix, no evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

Also, as noted in Section II of this appeal brief, there is a pending appeal before the Board for U.S. patent application serial number 10/315,514 titled "METHOD OF AND SYSTEM FOR INTEGRATING HEALTH INFORMATION INTO A PATIENT'S RECORD" (hereafter "the '514 application"), wherein one of the references at issue in the appeal for the '514 application is U.S. Patent Publication No. 2002/0029157 to Marchosky, which is similar to the *Marchosky* reference (U.S. Patent Application Publication No. 2003/0050803) applied in the rejection of the present application. No decision has been rendered as of yet in the appeal of the '514 application. No further related appeals are identified in Section II above, and thus as noted by the Related Proceedings Appendix, no decisions in any such related proceedings are provided.

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Respectfully submitted,



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VIII. CLAIMS APPENDIX

Claims Involved in the Appeal of Application Serial No. 10/727,184

1. A range-conversion method comprising:

receiving medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient's medical history that includes one or more data fields and a field value associated with each data field;

identifying one or more of said data fields as a range-based data field; and

defining, by an authorized user who has authorized access to the medical data records, a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields.

2. The range-conversion method of claim 1 wherein a text-string is associated with a specific data record.

3. The range-conversion method of claim 2 wherein the specific data record includes a range-based data field, the range-conversion method further comprising:

incorporating, into the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record.

4. The range-conversion method of claim 1 further comprising

generating a text-string for each data record, wherein each text-string includes one or more text-based data descriptors, such that each data descriptor includes:

a field descriptor that defines a specific data field within the data record to which the text-string is related, and

a value descriptor that defines the field value associated with the specific data field.

5. The range-conversion method of claim 4 wherein each text-string further includes a record identifier that identifies the data record to which the text-string is related.

6. The range-conversion method of claim 4 wherein a specific data record includes a range-based data field, the range-conversion method further comprising:

incorporating, as the value descriptor of the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record.

7. The range-conversion method of claim 6 wherein each data descriptor includes one or more starting characters, one or more separator characters, and one or more ending characters.

8. The range-conversion method of claim 7 wherein the field descriptor is positioned between the separator characters and one of the starting characters and the ending characters.

9. The range-conversion method of claim 8 wherein the value descriptor is positioned between the separator characters and the other of the starting characters and the ending characters.

10. The range-conversion method of claim 1 wherein each range of field values is a numeric range.

11-20. (Canceled)

21. A computer program product residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by the processor, cause that processor to:

receive medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient's medical history that includes one or more data fields and a field value associated with each data field;

receive user selection of one or more of said data fields as a range-based data field; and

receive user definition of a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for the selected one or more of the range-based data fields.

22. The computer program product of claim 21 wherein a text-string is associated with a specific data record.

23. The computer program product of claim 21 wherein the specific data record includes a range-based data field, the computer program product further comprising instructions for:

incorporating, into the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record.

24. The computer program product of claim 21 further comprising instructions for: generating a text-string for each data record, wherein each text-string includes one or more text-based data descriptors, such that each data descriptor includes:

a field descriptor that defines a specific data field within the data record to which the text-string is related, and

a value descriptor that defines the field value associated with the specific data field.

25. The computer program product of claim 24 wherein each text-string further includes a record identifier that identifies the data record to which the text-string is related.

26. The computer program product of claim 24 wherein a specific data record includes

a range-based data field, the computer program product of claim further comprising instructions for:

incorporating, as the value descriptor of the text-string associated with the specific data record, the text-based range descriptor that is associated with the field value of the range-based data field included in the specific data record.

27. The computer program product of claim of claim 26 wherein each data descriptor includes one or more starting characters, one or more separator characters, and one or more ending characters.

28. The computer program product of claim of claim 27 wherein the field descriptor is positioned between the separator characters and one of the starting characters and the ending characters.

29. The computer program product of claim of claim 28 wherein the value descriptor is positioned between the separator characters and the other of the starting characters and the ending characters.

30. The computer program product of claim of claim 21 wherein each range of field values is a numeric range.

31-40. (Canceled)

41. A searching system comprising:

a server system including a computer processor and associated memory, the server system having a database that includes a plurality of medical data records, wherein each of the medical data records includes at least a portion of a corresponding patient's medical history;

wherein the server system is configured to:

receive medical data records, wherein each data record includes one or more data fields and a field value associated with each data field, and wherein said field value includes a patient-specific value for the corresponding patient;

identify one or more of said data fields as a range-based data field that can accept any numeric value within a range of valid numeric values; and

define a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields, wherein each of the text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor.

42. The searching system of claim 41 wherein the server system is coupled to a distributed computing network.

43-52. (Canceled)

53. The range-conversion method of claim 1 wherein each of the defined text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor.

54. The range-conversion method of claim 1 wherein said authorized user comprises an authorized medical service provider of a patient.

55. The range-conversion method of claim 54 wherein said medical records are stored to a computer-based repository, and wherein said authorized medical service provider possesses an access key for the patient that permits access to at least a portion of the patient's medical records.

56. The computer program product of claim 21 wherein each of the defined text-based range descriptors represents a corresponding medical status of the patient reflected by field values contained in the range of field values associated with the text-based range descriptor.

57. The computer program product of claim 21 wherein said user comprises an authorized medical service provider of a patient.

IX. EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS APPENDIX

As noted in Section II of this appeal brief, there is a pending appeal before the Board for U.S. patent application serial number 10/315,514 titled “METHOD OF AND SYSTEM FOR INTEGRATING HEALTH INFORMATION INTO A PATIENT'S RECORD” (hereafter “the ‘514 application”), wherein one of the references at issue in the appeal for the ‘514 application is U.S. Patent Publication No. 2002/0029157 to Marchosky, which is similar to the *Marchosky* reference (U.S. Patent Application Publication No. 2003/0050803) applied in the rejection of the present application. No decision has been rendered as of yet in the appeal of the ‘514 application.

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board’s decision in this appeal.